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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,911	10/12/2001	Harold Ferdinand Van Garderen	0142-0362P	8931
2292 7590 07/02/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
TANG, KENNETH				
ART UNIT		PAPER NUMBER		
2195				
NOTIFICATION DATE		DELIVERY MODE		
07/02/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[mailroom@bskb.com](mailto:mailroom@bskb.com)

### Office Action Summary

**Application No.**

09/974,911

**Applicant(s)**

VAN GARDEREN ET AL.

**Examiner**

KENNETH TANG

**Art Unit**

2195

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-6 and 10 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-10 are presented for examination, wherein claims 1 and 6 are independent claims.
2. This action is in response to the Remarks on 5/28/08. The Examiner has replaced the Final Rejection of 8/27/08 with this current office action. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejections, based on the amendments to the claims on 4/30/07. Claims 6-10 have been added in the amendment on 4/30/7.

### ***Allowable Subject Matter***

3. Claims 2-4 and 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 5-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamzy (US 6,623,527 B1) in view of Maruta et al. (hereinafter Maruta).**

5. As to claim 1, Hamzy teaches a distributed document handling system for carrying out jobs, where jobs are carried out by services distributed over a network and where a job leads to a product (see Abstract), the system comprising:

a pool of services (list of selectable services), the services being distributed over a number of interconnected processing devices (Fig. 2, items 113, 101, 111, col. 13, lines 46-49);

specifying means for entering by a user a job specification comprising product specifications specifying the product to be delivered by the job and specifications, in considering selection from the pool of services (col. 13, lines 46-54);

determining means for determining a path of services, a path comprising at least two services, the services being selected from the pool of services, wherein the path is suitable to carry out the job in accordance with the product specifications, and wherein the determining means is operable to take into account circumstantial constraints for that job (col. 13, lines 46-54);

user interface means for presenting the paths suitable to carry out the job (col. 13, lines 28-30 and 50-54);

user interface means for, after the paths have been presented, enabling modification of the job specification by the user (button selected by user to pick a service from the service list) (col. 13, lines 28-30 and 50-54); and

means for, upon modification of the job specification, involving the determination means again for determining a path of services, based on the modified job specification (col. 13, lines 46-49).

6. Hamzy is silent in taking into consideration circumstantial constraints without effect on the product. However, Maruta discloses a printing system that determines and displays the cost/price of a printing service before executing the printing service (see Abstract, col. 2, lines 28-32, col. 3, lines 15-21). The cost/price is a circumstantial constraint that has no effect on the product. Hamzy and Maruta are analogous art because they are both in the same field of endeavor of a printing system. One of ordinary skill in the art would have known to modify Hamzy's printing system to incorporate the teachings of Maruta, specifically, determining and displaying the cost/price (circumstantial constraint without effect on the product). The suggestion/motivation for doing so is because Maruta states that it would be desirable to easily identify in advance the cost of the specific job before printing (col. 1, lines 12-13, 24-29, 35-36 & col. 2, lines 46-67). Thus, the user would be able to make a decision to select a service from the list/pool of services based on cost/price prior to executing the print job. Therefore, it would have been obvious to one of ordinary skill in the art to combine Hamzy and Maruta to obtain the invention of claim 1.

7. As to claim 5, Hamzy teaches wherein the processing devices are connected to each other by a local area network or the Internet (col. 1, lines 9-11).

8. As to claim 6, it is rejected for the same reasons as stated in the rejection of claim 1.

9. As to claim 10, it is rejected for the same reasons as stated in the rejection of claim 5.

***Response to Arguments***

10. During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

11. Applicant’s arguments have been fully considered but are moot in view of the new grounds of rejections.

***Conclusion***

Applicant’s amendment on 4/30/07 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH TANG whose telephone number is (571)272-3772. The examiner can normally be reached on 8:30AM - 6:00PM, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth Tang/  
Examiner, Art Unit 2195

/Meng-Ai An/  
Supervisory Patent Examiner, Art Unit 2195